

K. Takayama et al.
U.S. Serial No. 10/722,332
Page 6 of 8

RECEIVED
CENTRAL FILE CENTER
SEP 29 2006

REMARKS

Claims 1-18 are pending in the application. Independent claims 1 and 12 have been amended by the present amendment. Claims 17 and 18 were withdrawn from consideration as being directed to non-elected subject matter. The amendments are fully supported by the application as originally filed (see, e.g., specification at page 15, last paragraph to page 18, first paragraph).

Applicants' claimed invention is directed to a magnetic recording medium, **consisting of** a three-layer structure formed on a substrate, where the three layers are: (1) a metal layer 3, (2) a first magnetic layer 4, and (3) a second magnetic layer 5 that are stacked in this order (see independent claims 1 and 12; and FIG. 1 of application).

As amended, independent claims 1 and 12 recite that the magnetic recording medium consists of the above three-layer structure formed on the substrate, where the substrate is a "nonmagnetic substrate" (see, e.g., page 15, last paragraph, stating that the substrate 2 can be made of "glass, ceramics, or rigid plastic").

In other words, independent claims 1 and 12 have been amended to use the closed form "consisting of" language, instead of "comprising" as previously claimed. Moreover, the substrate must be a "nonmagnetic substrate" as claimed.

Claims 1, 4, 5, 7-9, 11, 12, and 14-16 were rejected under 35 USC 102(a) as anticipated by or, in the alternative, under 35 USC 103(a) as obvious over European Publication 1 098 306 to Hirokane et al. ("Hirokane"). Claims 2, 3, 6, 10, and 13 were rejected under 35 USC 103(a) as being unpatentable over Hirokane. These rejections are respectfully traversed.

In the Office Action of 07/31/2006 (as repeated from the Office Action of 02/09/2006), layers 2, 3, and 4 shown in FIG. 1 of Hirokane were cited as allegedly corresponding to the Applicants' claimed "metal layer," "first magnetic layer," and "second magnetic layer," respectively (see Office Action of 07/31/2006 at page 3).

K. Takayama et al.
U.S. Serial No. 10/722,332
Page 7 of 8

Hirokane does not teach or suggest the Applicants' claimed magnetic recording medium in which three layers are mounted on a substrate, and the substrate is a nonmagnetic substrate.

Hirokane discloses a four-layer structure in which a storage layer (first magnetic layer) 4, a magnetic flux-forming layer (second magnetic layer) 3, a non-magnetic intermediate layer 2, and a reproduction layer (third magnetic layer) 1 are stacked in this order (see paragraph 0019 of EP 1 098 306).

Hirokane is directed to a four-layer structure, not the three-layer structure recited in claims 1 and 12. The reproduction layer (third magnetic layer) 1 of Hirokane does not correspond to the Applicants' claimed "substrate" at least because it does not have the structure or function of a "substrate" as known to those of ordinary skill in the art. Moreover, the reproduction layer (third magnetic layer) 1 of Hirokane is not a "nonmagnetic substrate" as claimed.

For at least the reasons discussed above, the Hirokane reference does not anticipate or otherwise render obvious the Applicants' claimed invention as recited in independent claims 1 and 12.

Claims 1-16 were rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-20 and 22-31 of U.S. Patent 6,678,219 to Hirokane et al. However, at least because of the structural and functional differences discussed above, claims 1-20 and 22-31 of U.S. Patent 6,678,219 do not teach or suggest the Applicants' claimed invention as recited in claims 1-16. It is believed that the above arguments obviate the double patenting rejection.

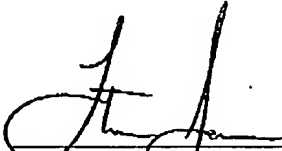
K. Takayama et al.
U.S. Serial No. 10/722,332
Page 8 of 8

It is believed the application is in condition for immediate allowance, which action is earnestly solicited.

Respectfully submitted,

Date: September 29, 2006

By:


Steven M. Jensen
(Reg. No. 42,693)

Edwards Angell Palmer & Dodge
P.O. Box 55874
Boston, MA 02205

Phone: (617) 439-4444

Customer No. 21874